

REMARKS

The Applicant appreciates the Examiner's courteous and quick final Office Action. The Applicant also greatly appreciates the Examiner's indication that claims 1-11, 14, and 17-28 are allowed.

Claims 1-11, 14, 17-25, 28, and 31-40 are pending in the application. Claims 31-40 stand rejected. Claim 31 has been amended herein. Claims 12-13, 15-16, 26-27, and 29-30 have been canceled. Applicant respectfully requests reconsideration in view of the following remarks.

Rejection Under 35 U.S.C. §112, First Paragraph

The Examiner has rejected claims 31-40 under 35 U.S.C. §112, first paragraph, contending that they are based on a disclosure which is not enabling. The particular types of metal ions critical or essential to the practice of the invention, but not included in the claim(s) are allegedly not enabled by the disclosure. The Examiner finds that Applicant's specification teaches that the metal ion is selected from Groups VIB, VIIB, VIIIB, IB and IIB, but such is not included in the claims.

The Applicant respectfully traverses, and respectfully directs the Examiner's attention to the amendments to claim 31 herein. It will be seen that the metal ion is further specified as "selected from the Periodic Table Groups VIB, VIIB, VIII, IB and IIB". It is respectfully submitted that support for this language is found in the application as filed on page 3 of the specification as helpfully noted by the Examiner, as well as in the paragraph [0023] bridging pages 6 and 7, and claims 1 and 19 as originally filed. Thus, this amendment does not constitute an improper insertion of new matter. It is respectfully submitted that this amendment overcomes the instant rejection by reciting particular types of metal ions. Reconsideration is respectfully requested.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Examiner has rejected claims 31-40 under 35 U.S.C. §112, second paragraph, alleging that they are indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Examiner finds that the claim as written does not positively state that the polyol is present. It states that the metal is effective to catalyze a polyol, but does not state that such a polyol is present.

The Applicant would again respectfully traverse and respectfully directs the Examiner's attention to claim 31 once more as amended herein. The term "at least one polyol" has been added to the recitation of the components of the aqueous fluid. Support for this addition is found in the application as filed in numerous places including claim 31 itself, where reference is made to "at least one polyol", but also at paragraph [0010] on page 3 and paragraphs [0020]-[0022] on pages 4-6. Thus, it is respectfully submitted that this amendment also does not constitute an improper insertion of new matter. It is respectfully submitted that this amendment overcomes the instant rejection by positively stating the presence of a polyol. It is further respectfully submitted that this change is made to clarify the claim, to correct an inadvertent clerical matter and not for any substantial reason related to patentability. Reconsideration is respectfully requested.

Rejection Under 35 U.S.C. §102

The Examiner has rejected claims 31-40 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Pat. No. 5,217,074 to McDougall, et al.

The Examiner finds that McDougall, et al. teaches a method of breaking a polysaccharide gel, such as guar crosslinked with boron, in a wellbore wherein a pelletized metal ion, such as sodium acetate, or sodium or potassium fluoride may be used as the breaker. The Examiner notes that since it is not clear that the polyol is present in the claim, such is allegedly anticipated by McDougall, et al.

The Applicant respectfully traverses.

A patent claim is anticipated, and therefore invalid, only when a single prior art reference discloses each and every limitation of the claim. *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047, 34 U.S.P.Q.2d 1565 (Fed. Cir.), cert. denied, 116 S.Ct. 516 (1995).

McDougall, et al. relates to granules containing a gel breaker used in a well treatment involving the use of a gelled fluid. The granules exhibit delayed release of the breaker to permit placement of the gelled fluid into the subterranean formation. There is no teaching or mention or suggestion of a polyol in the McDougall, et al. granules or method. As noted immediately above, independent method claim 31 has been amended to positively recite the presence of at least one polyol in the aqueous fluid composition. It is respectfully submitted that because the single prior art reference does not disclose each and every limitation of the claims, as amended either directly or by dependency, that the instant rejection is overcome by this amendment.

Reconsideration is respectfully requested.

Request for Withdrawal of Finality of Office Action

The Applicant respectfully requests that the finality of the instant rejection be withdrawn in accordance with MPEP § 706.07(e), as premature in accordance with MPEP §§ 706.07(a), (c) and (d), so as to permit the Applicants to respond to the new grounds of rejection.

It is noted that the Examiner has apparently conducted a *new* search and found one *new* reference, namely McDougall, et al. The present art rejection relies on the *new* reference and *none* of the references of the previous Office Action. The Applicant is at a loss to understand why it is proper to make the instant Action final, when the Applicant has not had an opportunity to respond to the new ground of rejection based upon a new reference. It is respectfully submitted that the Applicant has been inequitably deprived of his opportunity to fully address all points of rejection when a completely new rejection based on a completely new reference is entered and due to the finality of the Office Action the Applicant is not entitled to amend or argue against the rejection as a matter of right.

Section 706.07(e) of the MPEP states:

“Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be

completely obvious. Normally, the previous rejection should be withdrawn with respect to the claim or claims involved."

This paragraph is not exactly on point since it speaks in terms of a "previous final" rejection, but it is indicative of the view that a final rejection is improper in the case "where a *new* reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious," (emphasis added) such as is allegedly the case of the instant rejection.

Further, Section 706.07(a) of the MPEP states, in pertinent part:

"A second or any subsequent action on the merits in any application ... should *not* be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should have been reasonably expected to be claimed." [Emphasis added.]

It is respectfully submitted that Applicant's amendment of all of the claims in the previous Amendment to further recite the definition of a metal ion should have been reasonably expected because the metal ion was further identified in originally filed dependent claims 12-13, 15-16, 26-27 and 29-30, and in the specification at page 7, lines 3-7, as originally filed. Applicants respectfully submit that it is a reasonable expectation of an Applicant to overcome the previous art rejections in such a manner. Thus, withdrawal of the finality of the subject Action is respectfully requested.

It is the Applicant's expectation that the amendments and arguments presented herein will overcome all rejections and permit the remainder of the claims to be allowed. Thus, it is appreciated that the finality of the January 17, 2006 Office Action may be moot.

Request for Entry of Amendment

In the event the Examiner refuses to withdraw the finality of the instant Action, the Applicant would respectfully request entry of the subject Amendment.

The Applicant would respectfully request that the instant Amendment be entered under 37 CFR §1.116(b): "Amendments presenting rejected claims in better form for consideration on appeal may be admitted." It is respectfully noted that claims have been amended herein as helpfully suggested by the Examiner


himself. The Groups of the Periodic Table helpfully pointed out by the Examiner have been incorporated into independent claim 31 to further define the metal in the metal ion, and phrase "at least one polyol" has been explicitly included therein, as also helpfully suggested by the Examiner. It is respectfully submitted that for all of these reasons, which simplify and narrow the issues for possible appeal, the instant Amendment should be entered.

Further, the Applicant would respectfully submit that the instant amendment be entered under 37 CFR §1.116(c): "If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon showing of good and sufficient reasons why they are necessary and were not earlier presented." The Applicant submits that the reason why the amendments and arguments presented above are necessary and were not earlier presented is simply because *the rejections addressed were not earlier presented*, before the final rejection. For the Applicant to have any hope of being assured of a chance to address the instant rejections, the amendments and arguments herein must be entered and considered. While a new search and rejection based on that search may be proper, it is inequitable for such rejection to be designated as *final*. Again, Reconsideration is respectfully requested.

It is respectfully submitted that the amendments and arguments presented above overcome all of the rejections. Reconsideration and allowance of the claims are respectfully requested. The Examiner is respectfully reminded of his duty to indicate allowable subject matter. The Examiner is invited to call the Applicant's attorney at the number below for any reason, especially any reason that may help advance the prosecution.

Respectfully submitted,

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